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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,691	02/25/2002	Stephen Donovan	D-3018	5311

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EXAMINER	
MARX, IRENE	
ART UNIT	**PAPER NUMBER**
1651	

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/082,691	DONOVAN, STEPHEN	
	Examiner	Art Unit	
	Irene Marx	1651	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-9, 12, 17-19, and 22-27*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Irene Marx
Primary Examiner
Art Unit: 1651

Double Patenting

The rejection with respect to double patenting is withdrawn in view of proper terminal disclaimer presented..

Response to Arguments

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant's argue that the "therapeutically effective amount" specifically excludes an amount which kills the patient. That may be so, but the claims are drawn to undefined amounts of undefined compositions. From the allegations in the instant response, it is apparent that the amount provided is to be tailored to the specific patient as defined for each patient's perception of pain. Even though in the clinical setting there is an attempt to "quantify" pain by using a numeric scale, a visual analogue scale and a faces pain scale, as indicated in the Exhibit A provided, these various scales are notoriously imprecise and are not seen an providing a sufficiently reliable assessment to allow one of ordinary skill in the art to tailor a treatment so that a "therapeutically effective amount" of the large variety of compositions encompassed by the claimed designated composition can be provided. This is of paramount importance when one of the components of the composition is potentially deadly, even in small amounts.

Applicant's arguments that analogues can be readily determined is not persuasive, since the terminology used is not defined with any particularity in the as-filed specification. At page 19, paragraph 2, applicant mentions precursors, fragments and analogs, but does not define the products intended with any particularity. No "functional analogues" are defined.

The components intended have to be defined with precision, inasmuch as not only is the determination of a "therapeutically effective amount" required, but also a determination for each individual treated at a given time of the amount required to decrease the pain felt at that moment by about 20%, 40%, 50%, 60%, 80% or 100% for an unspecified length of time. In the Specification in Examples 2-3 one patient each with unspecified "neurogenic inflammation pain" is provided with compositions comprising various botulinum A components, wherein the amount are indicated as "for example" within a broad range. There is no indication of the source of the pain, for example, whether the pain pertains to arthritis, which is the elected species in the instant application. In the Examples 4-5, neither the botulinum component nor the substance P

component is specified and no amount is defined. In all of these examples, a clear indication is lacking of source of the pain; the dosage actually provided; the site and mode of administration and of the duration of the treatment to provide reduction of "pain symptoms" that are "substantially alleviated"; alleviated in 50%; alleviated in 80% (from 8 to "about 1 or 2").

Applicant baldly states that in claims 22 through 27 "in an amount that will reduce pain in a patient by..." is encompassed by a "therapeutically effective amount". However, applicant failed to point out the location in the specification where basis for this contention is to be found.

Even if pain could be arguably quantified in a given individual, the amount required to reduce pain still depends on the pain threshold and perception of the individual providing subjective "quantification" at the time of treatment, and this "quantification" is relative with respect to the severity of the condition and of the pain felt at a given moment. Inasmuch as pain is a psychological experience with an emotional dimension even the touted "quantification scales" cannot be standardized to be reliable to enable a consistent and reliable determination of a "therapeutically effective amount" for all of the various compositions claim designated for reduction of pain in the required percentages.

Therefore the rejection is deemed proper and it is adhered to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irene Marx
Primary Examiner
Art Unit 1651